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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,844	01/06/2006	Bum-Gyu Choi	29137.074.00	8704
30827 7590 12/31/2008 MCKENNA LONG & ALDRIDGE LLP 1900 K STREET, NW WASHINGTON, DC 20006				
EXAMINER				
CAMERON, ERMA C				
ART UNIT		PAPER NUMBER		
1792				
MAIL DATE		DELIVERY MODE		
12/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,844

Applicant(s)

CHOI ET AL.

Examiner

/Erma Cameron/

Art Unit

1792

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-2 and 4-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1: it is not clear what “substituted or unsubstituted with fluorine” modifies, only “carbon atoms” or all the species that precede the phrase (used twice).

b) Claim 4: it is not clear what “substituted or unsubstituted with fluorine” modifies, only “carbon atoms” or all the species that precede the phrase (used twice).

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The rejection of Claims 1-9 under 35 U.S.C. 112, first paragraph, is withdrawn because of the arguments presented in the 9/26/2008 amendment.

5. The rejection of Claim 6 under 35 U.S.C. 112, first paragraph, is withdrawn because of the amendment filed 9/26/2008.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The rejection of Claims 1-2 and 5-9 under 35 U.S.C. 102(b) as being clearly anticipated by Nishikawa et al (US2001/0055892) is withdrawn because of the amendment filed 9/26/2008.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al (US2001/0055892).

'892 teaches formation of an insulating film on a semiconductor device by hydrolyzing and condensing a silane of formula 1-3 and formula 4. In formula 1, R may be H, thus being hydrosilane. Water and organic solvent are present. A base catalyst like ammonia is also present. After application to a substrate, the coating is dried and cured. [0006]-[0015] [0046] [0129]-[0130]

In formula 1 of '892, when R=H and a=1, formula 1 meets the limitations of Formula 1 of claim 1.

The compounds of claim 4 are not required, as "other than hydrosilane compounds" is not a requirement of claim 2. However, formula 2 of '892 meets the limitations of formula 3 of claim 4 where p=0 and R4 is alkxy.

'892 fails to teach that the MW is at least 5000, but it would have been obvious to optimize the MW because the MW is known to affect the properties of a coating film.

Response to Arguments

The applicant has argued that '892 does not teach a MW of >5000. It is the examiner's position that a) the MW is not a critical element of the claimed invention (see the statement on page 13 that "it is usually preferred to set the molecular weight of the final product, 5000 or greater") and b) that MW is a conventional parameter to control when making a polymer and is selected based on the eventual use of the polymer, and that it would have been obvious to a skilled practitioner to optimize the MW.

10. Claims 1-2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over KR 20020097415.

See translation.

'415 teaches making an insulating membrane by hydrolysis condensing Chemical Formula 1 and 2. If R5 is H in formula 2, the polymer would meet the limitations of formula 1 of claim 1 (pages 2-3 of translation). Additives such as organic molecules may be present (p 10). A base catalyst may be present (p 14). The MW of the formed polymer is 500-1000000, which overlaps with the MW range claimed by applicant (p 15). After application to a semiconductor or other electronic device, the coating is dried and cured (p 17, 19).

11. Claims 1-2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over KR 20030000709.

See translation.

'709 teaches making an insulating membrane by hydrolysis condensing Chemical Formula 1, 2, 4 and 4. Formula 1 overlaps with formula 1 of claim 1, and formula 3 overlaps with formula 4 of claim 4 (pages 5-7 of translation). Additives such as organic molecules may be present (p 12). A base catalyst may be present (p 11). The MW of the formed polymer is 500-1000000, which overlaps with the MW range claimed by applicant (p 12). After application to a semiconductor or other electronic device, the coating is dried and hardened (p 13-16).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/
Primary Examiner
Art Unit 1792

December 26, 2008